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United States Patent & Trademark Office; U.S. DEPARTMENT OF COMMERCE

PRE-APPEAL REQUEST FOR REVIEW	Docket Number (Optional) 59643.00379
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed Name _____	Application Number: 10/781,666 Filed: February 20, 2004
	First Named Inventor: Jan KÅLL et al.
	Art Unit: 2617
	Examiner: Addy, Anthony S.

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ Applicant/Inventor.
☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under
37 CFR 3.73(b) is enclosed

☒ Attorney or agent of record.
Registration No. 51,091

☐ Attorney or agent acting under 37 CFR 1.34.
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July 9, 2007

Date

NOTE: Signatures of all of the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Jan KÅLL et al.

Application No.: 10/781,666

Filed: February 20, 2004



Confirmation No.: 5521

Art Unit: 2617

Examiner: Addy, Anthony S.

Attorney Dkt. No.: 59643.00379

For: CONTROLLING SENDING OF MESSAGES IN A COMMUNICATION SYSTEM

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

July 9, 2007

Sir:

In accordance with the Pre-Appeal Brief Conference Pilot Program guidelines set forth in the July 12, 2005 Official Gazette Notice, Applicant hereby submit this Pre-Appeal Brief Request for Review of the final rejections of claims 1-3, 6, 8-15, 18, and 20-33 in the above identified application. Claims 1-3, 6, 8-15, 18, and 20-33 were finally rejected in the Office Action dated March 9, 2007. Applicants filed a Response to the Final Office Action on June 5, 2007, and the Office issued an Advisory Action dated June 27, 2007 maintaining the final rejections of claims 1-3, 6, 8-15, 18, and 20-33. Applicants hereby appeal these rejections and submit this Pre-Appeal Brief Request for Review.

The Office Action rejected claims 1, 2, 6, 8, 12, 13, 14, 18, 20, 29, 30 and 33 under 35 U.S.C. 103(a) as being obvious over US Patent Publication No. 2002/0168978 to Molnar et al. (Molnar), in view of US Patent Publication No. 2002/0120600 to Schiavone et al. (Schiavone). The Office Action took the position that Molnar disclosed all of the features of these claims except wherein the restriction level defines a type of message which can be received by the at least one terminating party. The Office Action asserted that Schiavone disclosed this feature. As discussed in previous correspondence, Applicants submit that the cited references fail to disclose or suggest all of the features recited in any of the above claims. This failure constitutes clear

error in the Office Action. The independent claims and cited references were discussed at least in the Response that was filed on June 4, 2007.

Claim 1, from which claims 2-6 and 7-11 depend, is directed to a method for controlling sending of messages in a communication system. Claim 12 is directed to a computer program, comprising program code embodied on a computer readable medium, said computer program controlling a computer to perform a method as recited in claim 1. Claim 13, from which claims 14, 15, 18 and 20-28 depend, is directed to a communication system. Claim 29, from which claims 30-32 depend, is directed to a communication system. Claim 33 is directed to a network entity configured to receive and manage restriction information associated with terminating parties in a communication system.

Embodiments of the present invention provide a way of controlling the sending of a message and advantageously prevent a message being sent to an unwanted recipient due to a user error. Applicants respectfully submit that the cited references fail to disclose or suggest all of the features of these claims and fail to provide the advantages thereof.

As discussed in previous correspondence, Applicants submit that claims 1, 13, 29 and 33 similarly recite at least in part, the features of “the restriction information associated with the terminating parties is defined to comprise a restriction level for sending the message to the at least one terminating party wherein the terminating parties are classified into a plurality of restriction levels; sending of the message is controlled based on the restriction information, wherein the restriction level defines a type of message which can be received by the at least one terminating party.” The cited prior art fails to disclose or suggest at least these features of the invention. This failure constitutes clear error, and requires withdrawal of the rejections.

Molnar is directed to a method for restricting a message service in a communication network. The method seeks to restrict communication with certain addresses. Thus the sending of messages to, or receiving messages from a particular address may be blocked based on a record containing information about addresses with which a message communication is not allowed.

Schiavone describes a method for negotiating an electronic mail transaction. The method seeks to restrict receipt of certain messages by identifying a type of message and cross referencing the type of message with recipient profile data. Depending on the content of the

recipient profile data, filtering rules decide whether the email is delivered or not to the recipient. In this way, Schiavone reduces unwanted emails, e.g. spam (see paragraph 17 of Schiavone) received by the recipient.

Applicants submit that the Office Action failed to establish *prima facie* obviousness because the cited references fail to disclose or suggest all of the features recited in the pending claims, and because one skilled in the art would not be motivated to combine the teachings of the cited references. This failure constitutes clear error in the Office Action.

MPEP 2142 states that to establish *prima facie* obviousness there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. In addition, the prior art references must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on Applicants' disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998).

As previously discussed, Applicants note that the Office Action still maintains that Molnar discloses "defining a plurality of restriction levels associated with terminating parties". However as previously discussed, applicants submit that Molnar only determines whether an address is allowed or unallowed (see page 2, paragraph 0024 of Molnar). Applicants respectfully submit that Molnar is silent with regards to defining restriction information associated with terminating parties, nor is there any disclosure or suggestion of any restriction level which can be defined within the terminating parties and whether controlled sending of messages occurs based upon a plurality of restriction levels. Molnar merely discloses determining whether or not an address of a subscriber in a group of subscribers may send a message is simply not defining a plurality of restriction levels (see paragraph 0041). Further, Schiavone fails to cure the admitted deficiencies of Molnar. This, failure constitutes clear error in the Office Action.

As previously discussed, Applicants respectfully submit that the cited references, taken individually or in combination, fail to disclose or suggest at least the feature of sending of the

message is controlled based on the restriction information, wherein the restriction level defines a type of message which can be received by the at least one terminating party, as recited in claim 1 and similarly recited in claims 12, 13, 29 and 33. Specifically, Schiavone fails to cure the admitted deficiencies of Molnar.

As previously discussed, Schiavone merely discloses providing recipient profile data for a single user (see paragraphs 0016 and 0022). The recipient profile data of Schiavone is only concerned with one user. Schiavone merely discloses filtering the messages at the recipient's end (see paragraph 0033).

Therefore, in Schiavone, the recipient profile data simply cannot provide a plurality of restriction levels for other terminating parties, as recited in the present pending claims. Schiavone is silent on providing filtering rules for a plurality of recipients receiving the same message. Thus, Schiavone fails to cure the admitted deficiencies of Molnar.

As also previously discussed at least in the Response that was filed on June 4, 2007, Applicants submit that one skilled in the art would not be motivated to modify Molnar with Schiavone as alleged in the Office Action. As discussed in previous correspondence, Molnar is directed to preventing sending a message (see paragraph 0012 of Molnar), and Schiavone is directed to filtering a message at the recipient's terminal based on recipient profile data (i.e. the message having already been sent – see paragraph 0054 of Schiavone). Applicants submit that these two processes are different and are directed to achieving different objectives. For example, Molnar restricts a message service for a certain terminal [paragraph 0009 and 0011] and Schiavone filters emails based on certain conditions to stop unwanted emails – e.g. spam (see paragraph [0017]). These two references are not in the same field of endeavour. Thus, one skilled in the art would not be motivated to combine the references as alleged in the Office Action.

The Office Action also failed to establish the motivation for any modification to Schiavone to be carried out (in combination with Molnar or individually) when Schiavone only discloses filtering emails at a single terminal. That is, Schiavone fails to define restriction information associated with the terminating parties. Therefore, there is no reason at all for Schiavone to be modified such that the recipient profile data (of a single recipient) defines restriction information to be associated with a plurality of terminals. This is yet another reason

why there is no motivation to combine the two prior art documents. Thus, one skilled in the art would not be motivated to combine the teachings of Molnar and Schiavone. This combination of references and the resulting failure to establish *prima facie* obviousness constitutes clear error.

Based at least on the above, applicants submit that the Office Action failed to establish *prima facie* obviousness in rejecting claims 1-3, 6, 8-15, 18 and 20-33. This failure constitutes clear error in the Office Action.

Reconsideration and withdrawal of the rejections, in view of the clear errors in the Office Action, is respectfully requested. In the event this paper is not being timely filed, the applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,



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Enclosures: PTO/SB/33 Form
Notice of Appeal
Petition for Extension of Time
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